

REMARKS

Claims 1-10 are pending in the present application. Claims 1, 3-6 and 8-10 have been amended.

Priority Under 35 U.S.C. 119

Applicant notes the Examiner's acknowledgment of the Claim for Priority under 35 U.S.C. 119, and receipt of the certified copy of the priority document.

Disclosure

The disclosure has been objected to in view of the informalities listed on page 2 of the current Office Action dated June 27, 2005. The specification has been corrected to make specific reference to Figs. 2A – 2D, 5A – 5D, 8A – 8D and 9A – 9B. The Examiner is therefore respectfully requested to withdraw the objection to the disclosure.

Drawings

The drawings have been objected to, as the Examiner has required that Figs. 8A - 9B be designated as "PRIOR ART". Accordingly, enclosed are two (2) red-inked drawing Annotated Sheets, wherein Figs. 8A – 9B have been denoted as "PRIOR ART". Also enclosed are two (2) drawing Replacement Sheets, incorporating the above noted corrections. **The Examiner is respectfully requested to acknowledge receipt and acceptance of the drawing Replacement Sheets.**

Claim Objection

Claims 6-10 have been objected to under 37 C.F.R. 1.75 as being substantial duplicates of claims 1-15. This claim objection is respectively traversed for the following reasons.

Applicant emphasizes that the elements of claim 1 are set forth in step plus function format, and thus should be interpreted under 35 U.S.C. 112, sixth paragraph, wherein each step plus function element covers the corresponding acts in the specification and “equivalents” thereof. In contrast, the elements of claim 6 are set forth in generic terms, so as not to invoke 35 U.S.C. 112, sixth paragraph. Accordingly, claims 1 and 6 should thus be construed as having different respective scope. Applicant therefore respectfully submits that claims 6-10 are not substantial duplicates of claims 1-5, and thus respectfully urges the Examiner to withdraw this objection to the claims under 37 C.F.R. 1.75 for at least these reasons.

Claim Rejections-35 U.S.C. 112

Claims 1-10 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite, for the reasons stated on page 3 of the current Office Action. This rejection is respectfully traversed for the following reasons.

Claim 1 has been amended to feature a second step of “forming on the coated film resist patterns each having a plurality of pattern blocks including lines and spaces in which at least one of line widths and space widths are different from one another”.

Claim 6 has been amended in a somewhat similar manner. Although not necessarily limited thereto, the lines and spaces may be understood as described on page 12 of the present application, whereby portions of silicon substrate 201 which are covered with resist patterns 204 as shown in Fig. 2B result in line portions of the TEG pattern, and whereby portions uncovered by the resist patterns result in space portions, i.e., trenches. The claims have also been amended to improve antecedent. Applicant therefore respectfully submits that claims 1-10 are in compliance with 35 U.S.C. 112, second paragraph, and thus respectfully urges the Examiner to withdraw this rejection for at least these reasons.

Claim Rejections-35 U.S.C. 103

Claims 1-4 and 6-9 have been rejected under 35 U.S.C. 103(a) as being unpatentable over the Morita reference (U.S. Patent No. 6,905,966). This rejection is respectfully traversed for the following reasons.

STATEMENT CONCERNING COMMON OWNERSHIP

Applicant's representative respectfully submits that application U.S. Serial No. 10/768,076 and the Morita reference (U.S. Patent No. 6,905,966) were, at the time the invention of application U.S. Serial No. 10/768,076 was made, owned by Oki Electric Industry Co., Ltd.

Applicant respectfully emphasizes that in accordance with 35 U.S.C. 103(c) effective as of November 29, 1999, subject matter developed by another which qualifies as "prior art" only under one or more subsections of 35 U.S.C. 102(e), (f) or (g), is not to be considered when determining whether an invention sought to be patented is obvious under 35 U.S.C. 103(c), provided that the subject matter and the claimed invention were commonly owned at the time the invention was made. **Since the Morita patent and the present application were commonly owned at the time the invention of the present application was made, the Morita patent should not in this case be considered as prior art under the provisions of 35 U.S.C. 102(e).**

With further regard to this rejection, enclosed is a verified English translation of Japanese priority application 2003-352474, which was filed on October 10, 2003. A Claim of Priority under 35 U.S.C. 119 to Japanese priority application 2003-352474 is now perfected in the present application.

In accordance with Manual of Patent Examining Section 706.02(b), a rejection based on 35 U.S.C. 102(a) can be overcome by perfecting a Claim for Priority under 35 U.S.C. 119. **In view of the perfected claim of priority and the October 10, 2003 effective filing of the present application, the Morita patent (publication date of June 14, 2005), does not qualify as statutory prior art under the provisions of 35 U.S.C. 102(a).**

Applicant also respectfully emphasizes that the filing date of Japanese priority application 2003-352474 of the present application is earlier than the publication date

(February 26, 2004) of Japanese Priority Application No. 2002-219979 of the Morita reference.

Applicant respectfully submits that the Morita reference has been effectively removed as statutory prior art, and that the above noted rejection, insofar as it may pertain to claims 1-4 and 6-9, is improper for at least the above reasons, and should thus be withdrawn.

Allowable Subject Matter

Applicant respectfully notes the Examiner's acknowledgment that claims 5 and 10 would be allowable if rewritten to overcome the rejection under 35 U.S.C. 112, second paragraph, and to include all the limitations of the base claim and any intervening claims. Applicant however respectfully submits that claims 5 and 10 should be allowable by virtue of dependency upon claims 1 and 6 respectively, and that amendment of claims 5 and 10 to be in independent form is thus unnecessary.

Conclusion

The Examiner is respectfully requested to reconsider and withdraw the corresponding rejections, and to pass the claims of the present application to issue, for at least the above reasons.

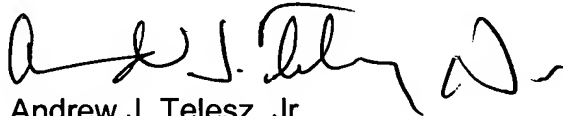
In the event that there are any outstanding matters remaining in the present application, please contact Andrew J. Telesz, Jr. (Reg. No. 33,581) at (571) 283-0720

in the Washington, D.C. area, to discuss these matters.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment for any additional fees that may be required, or credit any overpayment, to Deposit Account No. 50-0238.

Respectfully submitted,

VOLENTINE FRANCOS & WHITT, P.L.L.C.

A handwritten signature in black ink, appearing to read 'Andrew J. Telesz, Jr.', with a stylized flourish at the end.

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Enclosures: Two (2) drawing Annotated Sheets
Two (2) drawing Replacement Sheets
Verified English translation of Priority Application



FIG. 8A
PRIOR ART

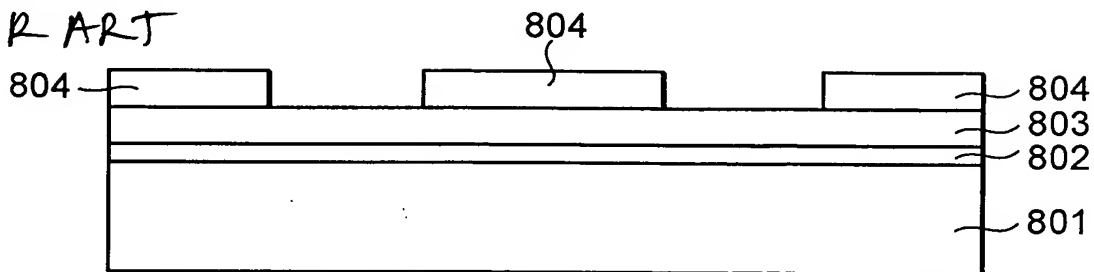


FIG. 8B
PRIOR ART

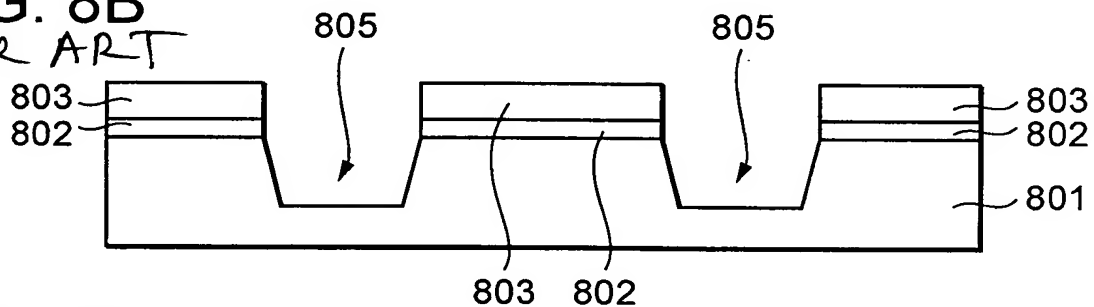


FIG. 8C
PRIOR ART

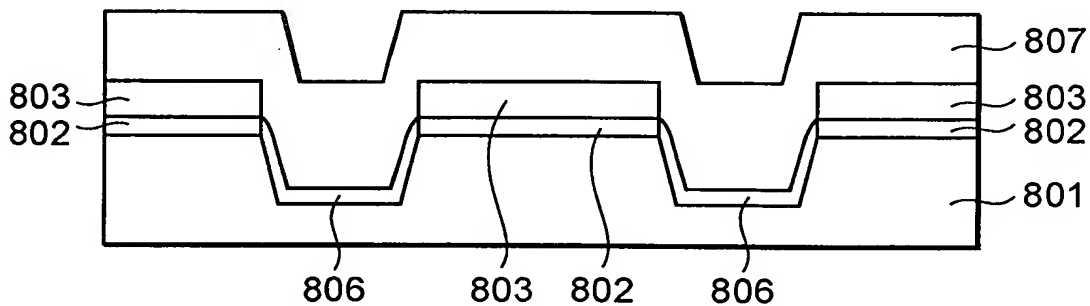


FIG. 8D
PRIOR ART

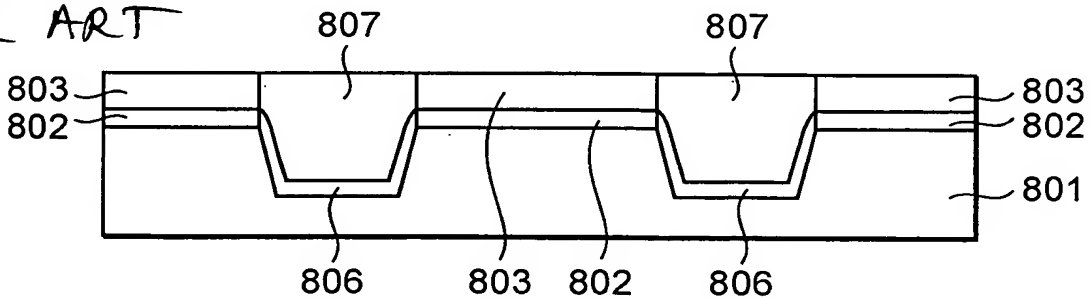


FIG. 9A
PRIOR ART

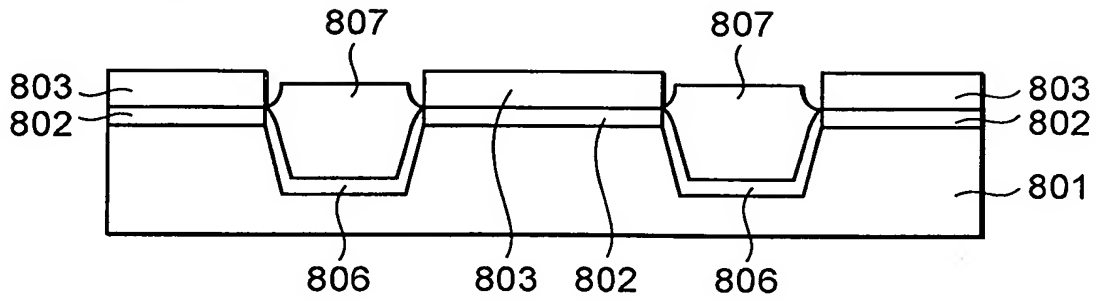


FIG. 9B
PRIOR ART

